

REMARKS

This response to the Office Action mailed on September 27, 2004 cancels no claims, amends claims 1-4 and 6-8, and adds new claims 22-23. As a result, claims 1-23 are now pending in this Application.

Allowable Subject Matter

Applicant acknowledges the allowability of claims 4 and 6 over the prior art. Claim 4 has been rewritten in independent form, to include all the recitations of its parent claims 1 and 2. Claim 6 has been recast in independent form, to include the recitations of its parent claim 1, and to overcome the rejection under 35 USC §112.

Applicant acknowledges the allowance of claims 10-21.

§112 Rejections

Claims 2-4 and 7-9 were rejected as indefinite under the second paragraph of 35 USC §112. Claims 2 and 3 are amended to delete the word “sufficiently.” Claim 7 is amended to recite clearly that the “base” recited therein is a piece that is “separate from the body,” whereas the other claims permit the base to be integral with the body. Claim 8 then recites that the body rotates relative to this piece.

These amendments do not narrow the scope of the claims.

§102 Rejections

Claims 1-3 and 5 were rejected under 35 USC §102(b) as being anticipated by Christopher (U.S. Patent No. 732,828).

As to claim 1, Christopher shows a device that serves a purpose foreign to Applicant's, the display of jewelry on a counter. Absent Applicant's disclosure, one skilled in the art would not consider modifying this jewelry display to convert it into “a holder for multiple documents.” Several aspects of Christopher's device make it entirely unsuitable for holding documents. For example, upwardly facing slots D in Figs. 1, 4, and 5 are not “curved” in any direction, much less in “a horizontal direction,” and thus would allow documents to bend over and thus be

unreadable. Single slot D in Fig. 3 faces horizontally in a plane parallel to the base, rather than “facing upwardly” as in amended claim 1. Christopher has no reason to combine multiple upward slots with a single curved slot, except in light of Applicant’s disclosure, which would constitute impermissible hindsight modification of the reference in a way that the reference neither teaches nor suggests.

Claims 2-3 and 5 depend from claim 1, and therefore inherit all its recitations. As to claim 2 specifically, Christopher has no concept of placing a document in any of his slots, and thus makes no provision for preventing “documents from bending.” Further, none of his slots could prevent document bending. The slots in Figs. 1, 4, and 5 are not curved at all, and the curve in Figs. 2 and 3 would be wholly insufficient to prevent a document held horizontally therein from bending over. As to claim 5, Christopher’s upwardly-facing slots are inclined slightly outwardly, rather than “toward the vertical axis of the body” as recited in claim 5.¹

§103 Rejections

Claims 7-9 were rejected under 35 USC §103(a) as being unpatentable over Christopher in view of Scott et al. (U.S. Patent No. 6,446,929).

First, claim 7 depends from claim 1, and the primary Christopher reference does not reach all of the recitations of that claim, either directly or by any modification except in light of Applicant’s disclosure. The mere addition of a generic base from Scott cannot make up any of the differences from Christopher as previously noted. Scott supports documents on shelves, not in any sort of slots. The books shown in Scott are in any event much too bulky to suggest to one skilled in the art that some other form of document support might be employed instead.

Claims 8-9 depend from claim 7, and accordingly incorporate all the recitations of their parent.

New claims 22-23 also depend from claim 1. Claim 22 recites faces extending at least partially “between all adjacent ones” of the upwardly slanting edges of claim 1. Christopher has no face at all between the rear edges of pieces B in any of Figs. 1-5. Scott has no faces at all between either side of plate 11 and plate 12. Claim 23 depends from claim 22.

¹ ---Figs. 1 and 5 show the slots parallel to the edges of the cardboard pieces B. When the pieces are folded along line A, both the edges and the slots thus tilt away from---or at least not toward---a vertical axis to the apex.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

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Conclusion

For the above and other reasons, Applicant urges that the claims meet all statutory requirements. Applicant therefore respectfully requests reexamination under 35 USC §132 and allowance of the Application in its present form. The Examiner is invited to telephone Applicant's attorney at (612) 373-6971 if deemed helpful to prosecution of this Application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 20 day of December, 2004.

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